

REMARKS

Entry of the foregoing amendment is respectfully requested. The Amendment is believed to place the application in condition for allowances and is, therefore, appropriate under Rule 116. The Amendment does not raise any new issues and, thus, does not require an additional search by the Examiner. The issues raised by the amended claim 1 are the same issues raised by the presently pending claims 1, 4, and 6.

The Amendment was not earlier presented because applicant did not fully appreciate the grounds for rejection until they were set forth again in the final Office Action.

By the present amendment, claims 4 and 6 are canceled, and claim 1 is amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejected Claim(s) 1, 2, 4, 6, 7 under 35 U.S.C. § 102(b) as anticipated by Leonardo et al., U.S. Patent No. 3,652,003 (Leonardo). Claims 1-2

and 4-7 were also rejected under 35 U.S.C. § 102(b) as being anticipated by De Caro et al., U.S. Patent No. 3,171,131 (De Caro). It is respectfully submitted that Claims 1, 2, 4, 5 and 7 are patentable over the cited references.

Specifically, Claim 1 recited that the second region which extends from the first region in a direction toward an end of a bolt guide remote from the combustion chamber, has an inner diameter smaller than the inner diameter of the first region for braking a fastening element during a driving process. Claim 1 further recites that the bolt guide has a third region adjoining the second region and having an inner diameter greater than the inner diameter of the second region. Still further, claim 1 recites that transition regions between the first and second regions and between the second and third regions are each formed as inclined surface.

As explained in the specification (page 4, second paragraph), braking of the fastening element causes deceleration of the setting piston. Therefore, in the first phase of combustion in the combustion chamber, a sufficiently high energy is built up, which permits subsequently to drive the fastening element with full power. This, in turn, insures a complete return of the piston into its initial position. As further explained in the specification inclined surfaces between the regions insure a

friction-free transition of the fastening element and the guide element from one region to another.

Providing a bolt guide of the type discussed above for braking a fastening element displaceable through the bolt guide during a setting or driving process is not disclosed in the prior art, including Leonardo and De Caro.

In Leonardo, the second region (with a smaller diameter) extends from the first region having a greater diameter in a direction away from the free end of the bolt guide and does not design to brake a fastening element during the driving process. The first region of Leonardo with a greater diameter is designed to allow the end of the drive piston to easily drive into the muzzle. Further the conically widened end of the muzzle (15) has at no time contact with the fastener as the piston rod (46) with the impact port (47) project into the muzzle part and the conically widened end. Therefore, the conically widened end cannot brake the fastener during the setting process. It is to be noted that the fastener never passes what the Office Action considers “the third region” (column 4, lines 70-74).

The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . . [a]nticipation requires the presence in a single prior art

disclosure of all elements of a claims invention arranged as in the claim” (emphasis added). Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, S.A. v. Cooper Life Science, 32 U.S.P.Q. 2d at 1019 (Fed. Cir. 1994). Verdegaal Bros. Inc. v. Union Oil Co., 2 U.S.P.Q. 2d at 1053 (Fed. Cir. 1987).

Even if we assume *arguendo*, that Leonardo disclose all (?) of the elements of Claim 1, they are clearly arranged not as in the Claim.

Since Leonardo fails to disclose each and every feature of independent Claim 1, Leonardo, as a matter of law, does not anticipate the present invention, as defined by said independent claim.

De Caro likewise does not anticipate or makes obvious the present invention. In De Caro, the ball (48) is located, together with the spring (49) in a recess (46c) provided on one side of the guide axis. The assembly ball (48)-spring (49) is designed for retaining the fastening element against falling-out in the vertical position of the tool before start of the setting process (column 4, lines 71-75). The elastic force of the rubber spring (49) would be insufficient to cause braking of the movable fastening element. Furthermore, in its retaining position,

the ball (48) holds the fastener with its central zone. At the start of the setting process, the fastener passes this zone and is accelerated in the setting direction.

According to case law, in order to meet a “means-plus-function” limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578 27 U.S.P.Q. 2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus, Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 U.S.P.Q. 2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 U.S.P.Q. 2d 1382, 1386 (Fed. Cir. 1989).

In De Caro, the ball-rubber spring assembly does not and cannot perform the same function (an identical function) as the second region of Claim 1. No braking effect takes place after the start of the setting process.

In view of the above, it is respectfully submitted that De Caro does not anticipate or makes obvious the present invention, as defined by Claim 1, and that Claim 1 is patentable over De Caro.

Claim 2, 5 and 7 depend on Claim 1 and are allowable as being dependent on an allowance subject matter.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction to be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

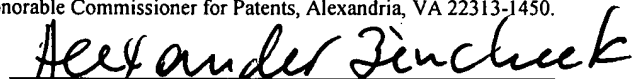


Alexander Zinchuk

Reg. No. 30,541

Date: September 19, 2005
Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017-5621
212-885-9383

This correspondence is being deposited with the United States Postal Service on September 19, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **ER 843 205 051** US addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.


Alexander Zinchuk